

PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 2612

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Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Inventor(s):

Manico, et al.

Group Art Unit: 2622

Examiner:

James M. Hannett

TITLE: METHOD OF USING A
PORTABLE SYSTEM FOR
CAPTURING IMAGES

Serial No.: 10/017,831

Filed: December 7, 2001

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the Final Office Action dated 13 December 2007, in the above-identified application. No amendments are being filed with this request. This request is being filed with a request to reinstate the previously filed Notice of Appeal filed 22 March 2007, and a request for a two-month Extension of Time. The claims are as filed in the response filed 10 September 2007.

INFORMATION DISCLOSURE STATEMENT

The Examiner asserts that the reference provided with the Response filed 10 September 2007 should be cited in an Information Disclosure Statement. However, the reference is from 2006, and, as admitted by the Examiner, does not constitute prior art. Under 37 CFR 1.56, only information material to patentability must be disclosed. Because the supplied reference was published after filing of the application, the reference is not material to patentability, and disclosure in an Information Disclosure Statement is 1) unnecessary by Applicants and 2) would waste the Examiner's time with non-relevant art. The reference was submitted to

prove Applicants' point that no hand-portable minilabs are known to be commercially available, even after the time of Applicants' filing.

**REJECTION OF CLAIMS 1, 23, 25-27, 28 AND 31 OVER UEDA ALONE,
OR IN COMBINATION WITH REDD ET AL.**

Claims 1, 23, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,429,923 Ueda et al. Claims 28 and 31 are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,429,923 Ueda et al. in view of U.S. 2004/0109147 A1 Redd et al. (Applicants note the Examiner erroneously argued allowed claims 29 and 30, but presume this was a typographical error and the same arguments apply to claims 28 and 31 for purposes of this response.) Applicants respectfully assert the Examiner has failed to prove a *prima facie* case of obviousness in either rejection for at least the following reasons.

Claims 1, 26, and 27 are independent, all other rejected claims depending therefrom. Claims 1, 26, and 27 all require that the imaging device or imaging system be portable by hand (claim 1) or hand-carriable (claims 26 and 27). The claims further require transporting a hand-carriable imaging system or hand portable imaging device to a first location or from a first location to a second location, receiving a hardcopy document from a user at the location, and scanning the document at the user's location using the hand-carriable imaging system or hand portable imaging device. Claim 1 further requires receipt of an order request and forwarding of the digital image from the hand portable imaging device to a fulfiller to fulfill the order request. Claim 26 requires transporting the hand-carriable imaging system from the user's location to a second location remote from the user's location (first location). Claim 27 requires storing the digital image in the memory of the hand-carriable imaging system, and generating an order associated with the stored digital image.

The Examiner provides reasons for allowance for claims 2-7, 9-11, 13-22, 24, 29, and 30 as follows:

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art does not teach the method of sequentially transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

Applicants submit the reasons for allowance provided describe the subject matter of independent rejected claims 1, 26, and 27. Thus, Claims 1, 23, 25-28, and 31 should be allowed for at least the same reasons as claims 2-7, 9-11, 13-22, 24, 29, and 30.

Further, the Examiner has not provided a *prima facie* case of obviousness. As set forth in the response of 10 September 2007, Ueda et al. shows a movable minilab, having wheels 302, as shown in Figs. 5 and 6, and stanchions or legs 202, used for leveling the device prior to use, as would be recognized by one of ordinary skill in the art. Because the minilab uses chemicals for processing, a level surface must be ensured for proper maintenance of chemical levels in processing. As shown, Ueda et al. is movable, or portable, but not in such a manner as to be carried by hand. The Examiner has taken official notice in the 6 July 2007 Office Action and in the 13 December 2007 final Office Action that it:

would have been notoriously obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the imaging system of Ueda et al. in order to make it small enough to be carried by hand. ...such a modification would have involved a mere change in the size of a component.

Further, in the 13 December 2007 final Office Action, the Examiner has taken Official Notice that:

it as notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size

as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved by hand.

The Examiner also points to Applicants' supplied reference ("A Survey of Digital Minilabs in the USA," Photoreporter, No. 11, Vol. 14, June 11, 2006, herein called the "2006 reference") as teaching that a minilab is hand-carriable, stating:

Photoreporter described on Page 4, Line 9-11 that tabletop SP500 scanner has a footprint of 1X2 feet and weighing less than 50 pounds. The examiner asserts that a device that is less than 50 pounds and is 1 foot by 2 feet is a hand-carriable device. Although The[sic] Photoreporter reference is not prior art, it shows that Current[sic] mini-labs are a size small enough to be carried by hand.

Applicants note that the Examiner in the 13 December 2007 final Office Action is discussing scanners, not minilabs. A scanner and a minilab are not equivalent, as known to those skilled in the art of photo-reproduction. A scanner is comprised of mechanical and electrical components, which can be reduced in size as technology improves. However, a minilab requires a series of chemicals for wet processing of photographic materials, requiring a certain volume of chemicals and room for each separate chemical bath, as known in the art of photographic processing. It is not understood by Applicants, or shown by the Examiner, how one can simply reduce the size of a minilab and have it function as intended.

The primary reference applied is Ueda, directed to a minilab. The secondary reference of Redd et al. is only used for teaching recording of audio input on the back of an image in coded form. No applied reference teaches transporting a hand-carriable imaging system or hand portable imaging device to a first location or from a first location to a second location, receiving a hardcopy document from a user at the location, and scanning the document at the user's location using the hand-carriable imaging system or hand portable imaging device.

The Examiner appears to rely on Applicants 2006 reference as showing portable scanners. However, as admitted by the Examiner, the 2006 reference is improper as prior art, having been published after filing of Applicants' application. The Examiner has provided no teaching, disclosure, or suggestion of reducing an imaging device, particularly one with a memory, to a

hand portable or hand-carriable size before the time Applicants filed this application.

As shown by Applicants' submission of the 2006 reference, no one had, up to the time of the 2006 reference, successfully introduced a hand portable imaging device or hand-carriable imaging system. Applicants claimed invention fills a long felt and unmet need in the art.

The primary reference of Ueda et al. shows in Figs. 9-14 that goods and materials related to photoprocessing are moved between the minilab and a photofinishing place, a customer, or a pick-up location, but the minilab itself is not moved. The Examiner has provided no prior art demonstrating or suggesting a hand portable imaging device or hand-carriable imaging system.

As set forth above, the final rejection is clearly in error, a prima facie case of obviousness not having been established.

Applicants note claims 2-7, 9-11, 13-22, 24, 29, and 30 are allowed. Applicants submit all claims are in condition for allowance for at least the reasons herein. A prompt and favorable action in response to this request is thus earnestly solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.